

REMARKS

In the above referenced Office Action, the Examiner rejected Claims 14-23 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. the Examiner, in support of this rejection, stated, "The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 14 recites the limitation where the bodysuit member has a size and shape which allows intense aeration with intermittent moist treatment without additional exposure to contaminants. Claim 14 further recites a texture that permits alternating circulation of a gaseous fluid and a liquid fluid. There is no support in the specification for these functional limitations.

Applicant's specification only provides support for a medium that is at least one of a liquid and a gas (col. 6, lines 1-3). Applicant's specification does not provide any support for the size and shape of the body or its inner texture permitting either intermittent or alternating treatment with or circulation of a gaseous fluid and a liquid fluid. Applicant's specification merely indicates that the textured inner surface

permits circulation (page 7, lines 10-24). Applicant's specification does not provide for 'intense aeration.'

Claims 15-23 are rejected for depending from a claim that is not enabled."

Applicant has cancelled Claims 16 and 19 and amended Independent Claim 14 to remove the limitation of "intense aeration". The Examiner's comment with respect to the textured inner surface is believed to be in air since this disclosure was disclosed in the parent case. Accordingly, the Examiner is respectfully requested to withdraw his rejection of Claims 14, 15, 17, 18 and 20-23 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Further, the Examiner rejected Claims 14-23 under 35 U.S.C. § 103(a) as being unpatentable over Eriksson (US 5,152,757 A) in view of Lockwood et al. (US 6,685,681 B2; hereinafter "Lockwood"), stating, "Regarding claim 14, Eriksson teaches a device capable of both treating and promoting healing of damaged body tissue, said device comprising; a bodysuit member (60) having each of a predetermined size and a predetermined shape which is capable of allowing aeration with intermittent moist treatment without additional exposure to contaminants, said bodysuit (60) having an outer surface facing atmosphere and an inner surface facing a body area of a person to be treated; and at least one fluid transfer means (88) sealingly engaged with

said bodysuit space and disposed in fluid communication with a space located between said inner surface of said bodysuit and said damaged body tissue that is capable of allowing communication of at least one predetermined fluid medium to such space disposed between said inner surface of said bodysuit and such damaged body tissue thereby enabling such damaged body tissue (see figs. 9 & 15, below)(col. 20, lines 62-65; col. 21; lines 51-68)(abstract).

Eriksson does not expressly teach that the inner surface of the bodysuit member is textured.

Lockwood teaches a vacuum bandage that includes a wound-contacting layer (20) with a texture (28) which channels fluids (see fig. 16, below).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to add the textured channels of Lockwood to the system of Eriksson in order to provide fluid flow channels even in portions of the system that are compressed by a wearer's bodyweight, so fluid can circulate.

Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. § 103(a).

Ex Parte Smith, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007)(citing *KSRv. Telejlex*, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly, Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent persuasive evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. § 103(a).

Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007)(citing *KSR*, 127 S.Ct. at 1740, 82 VSPQ2d at 1396). Accordingly, since the applicant[s] have submitted no persuasive evidence that the combination of the above elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. § 103(a) because it is no more than the predictable use of prior art elements according to their established functions resulting in the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement.

Eriksson and Lockwood do not expressly disclose the functional limitations concerning how the device is sized, shaped or textured to permit alternating or intermittent

application of gas and liquid with out requiring removal of the bodysuit member.

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 VSPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

The express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103. "The inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness." *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995) (affirmed a 35 U.S.C. 103 rejection based in part on inherent disclosure in one of the

references). See also *In re Grasselli*, 713 F.2d 731,739,218 VSPQ 769, 775 (Fed. Cir. 1983).

Eriksson and Lockwood teach a bodysuit inherently sized and shaped such that they permit, or at least do not preclude alternating application of gas and liquid without removing the bodysuit member. For example, a source of liquid can be attached to one of the Eriksson's inlet ports (28) and can be replaced with a source of gas, all while the body suit remains attached to a wearer.

Further regarding claim 14, Lockwood teaches a texture (28) that permits or at least does not preclude alternating circulation of gas and liquid.

Regarding claim 15, Eriksson teaches transparency (col. 2, line 34).

Regarding claim 16-18, Eriksson teaches multiple ports (88)(fig. 15).

Regarding claims 19-22, Eriksson teaches that the fluid is a liquid medication, painkiller or both (col. 6, lines 55-68).

Regarding claim 23, Eriksson teaches a bodysuit member (60) that covers an entire body, figure 15, *infra*."

Independent Claim 14 has been amended to now specifically recite, "...at least three ~~one~~ fluid transfer means sealingly engaged with said bodysuit member and disposed in fluid communication with a space located between said inner surface of

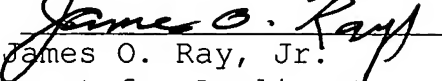
said bodysuit member and such damaged body tissue, a first one of said fluid transfer means for allowing communication of ~~at least one~~ said gaseous predetermined fluid medium and a second one of said fluid transfer means for allowing communication of said liquid fluid to such space disposed between said inner surface of said bodysuit member and such damaged body tissue thereby enabling such damaged body tissue to be effectively treated and healed in controlled environmental conditions without requiring removal of said bodysuit member and a third one of said fluid transfer means for removing each of said gaseous and liquid fluids from said bodysuit."

Clearly, this arrangement has not been taught or suggested by the cited art. Accordingly, the Examiner is respectfully requested to withdraw his rejection of Claims 14, 15, 17, 18 and 20-23 under 35 U.S.C. § 103(a) as being unpatentable over Eriksson in view of Lockwood et al.

In the event that the Examiner has any further difficulties with the allowance of the application, he is invited to contact the undersigned attorney/agent by telephone at (412)380-0725 to resolve any remaining questions and/or issues by telephone interview and/or by Examiner's amendment as to any subject

matter that will help expedite the completion of the prosecution
of this application.

Respectfully submitted,

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